

ESTTA Tracking number: **ESTTA991621**

Filing date: **07/31/2019**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Disney Enterprises, Inc.
Granted to Date of previous extension	07/31/2019
Address	500 SOUTH BUENA VISTA STREET BURBANK, CA 91521 UNITED STATES

Attorney information	LINDA K MCLEOD KELLY IP LLP 1300 19TH ST NW SUITE 300 WASHINGTON, DC 20036 UNITED STATES linda.mcleod@kelly-ip.com, clint.taylor@kelly-ip.com, lit-docketing@kelly-ip.com no phone number provided
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Applicant Information

Application No	88191350	Publication date	04/02/2019
Opposition Filing Date	07/31/2019	Opposition Period Ends	07/31/2019
Applicant	Qianhai Qisheng Supply Chain ManagementShenzhen Co., Ltd. Room 201, Building A, No. 1 Qianwan 1st Road Shenzhen-Hong Kong Cooperation Zone Qianhai, Shenzhen, 518052 CHINA		

Goods/Services Affected by Opposition

Class 028. First Use: 2018/10/01 First Use In Commerce: 2018/10/01 All goods and services in the class are opposed, namely: Balloons; Confetti; Infant toys; Inflatable thin rubber toys; Novelty noisemaker toys for parties; Play balloons; Stress relief exercise toys; Toy building blocks; Toy fireworks
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2700605	Application Date	08/08/1994
Registration Date	03/25/2003	Foreign Priority	NONE

		Date	
Word Mark	HAKUNA MATATA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2002/04/17 First Use In Commerce: 2002/04/17 T-shirts		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	HAKUNA MATATA		
Goods/Services	toys; children's toys; clothing; apparel; T-shirts; jewelry; mugs; accessories.		

Attachments	HAKUNAMATATA - Notice of Opposition.pdf(550622 bytes)
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Signature	/Linda K. McLeod/
Name	LINDA K MCLEOD
Date	07/31/2019

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>DISNEY ENTERPRISES, INC.,</p> <p style="text-align:center">Opposer</p> <p style="text-align:center">v.</p> <p>QIANHAI QISHENG SUPPLY CHAIN MANAGEMENT SHENZHEN CO., LTD.,</p> <p style="text-align:center">Applicant.</p>	<p>Opposition No.:</p> <p>Mark: HAKUNAMATATA Serial No.: 88191350 Filed: November 13, 2018</p>
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NOTICE OF OPPOSITION

Opposer, Disney Enterprises, Inc. (“Opposer”), a corporation of the State of Delaware, having a principal place of business at 500 South Buena Vista Street, Burbank, California, 91521, believes that it is being damaged, and will be damaged, by the registration of Qianhai Qisheng Supply Chain Management Shenzhen Co., Ltd.’s (“Applicant”) HAKUNAMATATA mark shown in Application Serial No. 88191350, and hereby opposes the same. As grounds for opposition, Opposer alleges that, upon actual knowledge with respect to Opposer’s own acts, and upon information and belief as to other matters:

Opposer and its Business

1. Opposer, Disney Enterprises, Inc., is a corporation of the State of Delaware, having a principal place of business at 500 South Buena Vista Street, Burbank, California, 91521.
2. Opposer, through its related companies and licensees, is one of the world’s leading producers and providers of entertainment, films, music, and consumer

products. Opposer engages in a vast licensing program under which it uses or licenses the use of its properties and characters in connection with a wide variety of products and services, including but not limited to entertainment services, television programs, motion picture films, interactive theme parks, toys, infant toys, children's toys, balloons, party supplies, apparel, books, comic books, music, video games, computer software, and mobile applications, among many other things.

**Opposer's The Lion King Franchise and Common Law Rights
in HAKUNA MATATA**

3. Since long before the filing date of the opposed application, Applicant's claimed date of first use, and any date of first use that Applicant may prove, Opposer, through its predecessors, related companies, and licensees, has used HAKUNA MATATA in connection with Opposer's well-known and enormously successful *The Lion King* films, television shows, musicals, sound recordings, books, video games, theme parks, and collateral merchandise (collectively, "The Lion King Franchise").

4. Opposer's The Lion King Franchise includes Opposer's 1994 animated film *The Lion King*, in which Opposer first used HAKUNA MATATA, including as the title of a song composed by Elton John and performed by the characters Simba, Timon, and Pumbaa. Opposer's 1994 *The Lion King* film was a tremendous success winning two Academy Awards and two Golden Globe Awards, and Opposer's *Hakuna Matata* song was nominated for the Academy Award for best original song. Opposer's 1994 *The Lion King* film was the highest grossing film release of 1994 and is among the highest-grossing feature films of all time.

5. Opposer's The Lion King Franchise also includes Opposer's 1994 album *The Lion King: Original Motion Picture Soundtrack* that features songs from *The Lion*

King film, and HAKUNA MATATA is the title of a song on that album. Like the 1994 film, Opposer's *The Lion King: Original Motion Picture Soundtrack* was a tremendous success and is the best-selling soundtrack to an animated film in the United States with several million copies sold. Opposer's *Hakuna Matata* song is catchy and immediately recognizable to millions of people in the United States.

6. Given the tremendous success of *The Lion King* film and soundtrack and to further build consumer awareness of The Lion King Franchise, Opposer, through its related companies and licensees, for years has offered a Broadway musical titled *The Lion King* beginning 1997 and continuing today. Opposer's musical also features HAKUNA MATATA, including as the title of the well-known *Hakuna Matata* song. Like the film and soundtrack, *The Lion King* Broadway musical has been an enormous commercial success receiving six Tony Awards including Best Musical, and Opposer's *The Lion King* Broadway musical is the highest grossing Broadway production of all time.

7. Opposer's most recent addition to The Lion King Franchise is Opposer's 2019 film *The Lion King* that is a reimagined adaptation of the 1994 film of the same name and features the voices of Beyoncé, Donald Glover, Seth Rogen, Billy Eichner, and James Earl Jones, among numerous other actors. HAKUNA MATATA is featured in the film, including the well-known *Hakuna Matata* song. That film is still in theaters and has been a tremendous commercial success earning over \$191 million dollars in its opening weekend, which is the eighth-highest grossing weekend in domestic box office history. That film has also received extensive unsolicited media attention in numerous widely distributed publications including *The New York Times*, *The Hollywood Reporter*,

The Wall Street Journal, *The Los Angeles Times*, *Variety*, *Forbes*, *The Washington Post*, and *USA Today*, among many others.

8. Opposer also recently released a 2019 album titled *The Lion King: Original Motion Picture Soundtrack* that features reimagined adaptations of music from Opposer's 1994 album of the same name along with new music. HAKUNA MATATA is the title of a song on Opposer's 2019 album that is performed by Donald Glover, Seth Rogen, and Billy Eichner. The album also includes songs performed by Beyoncé and Elton John.

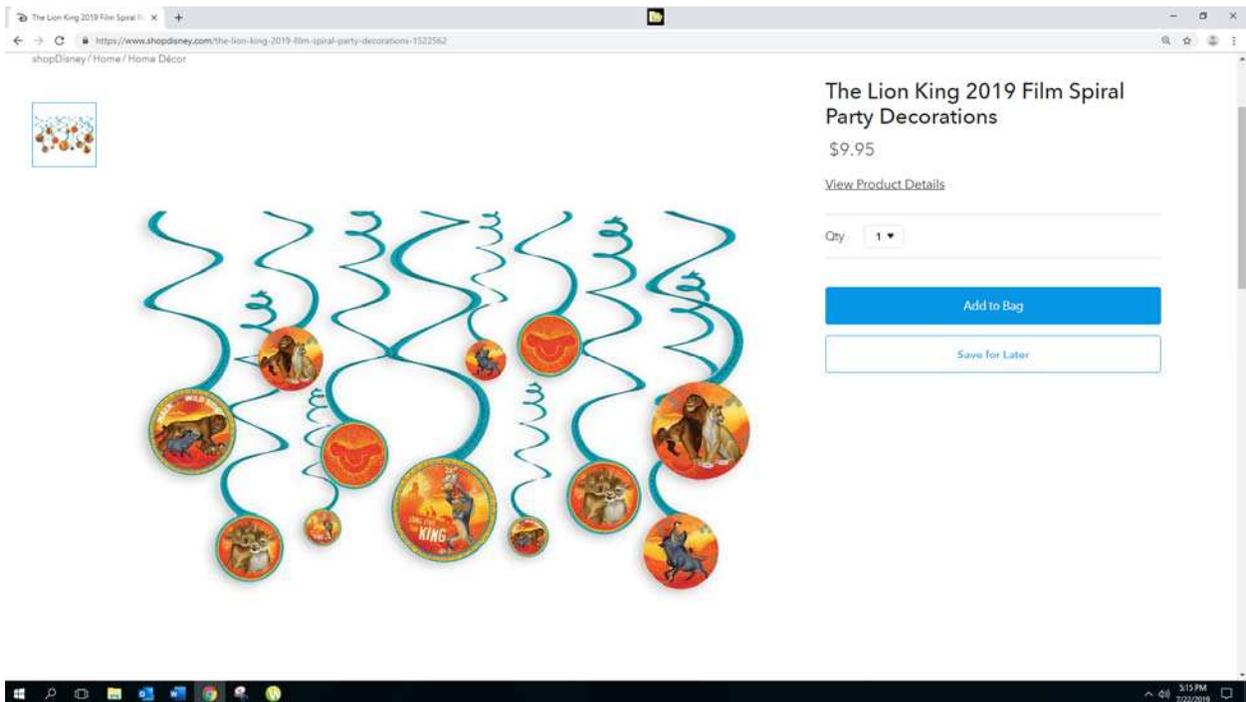
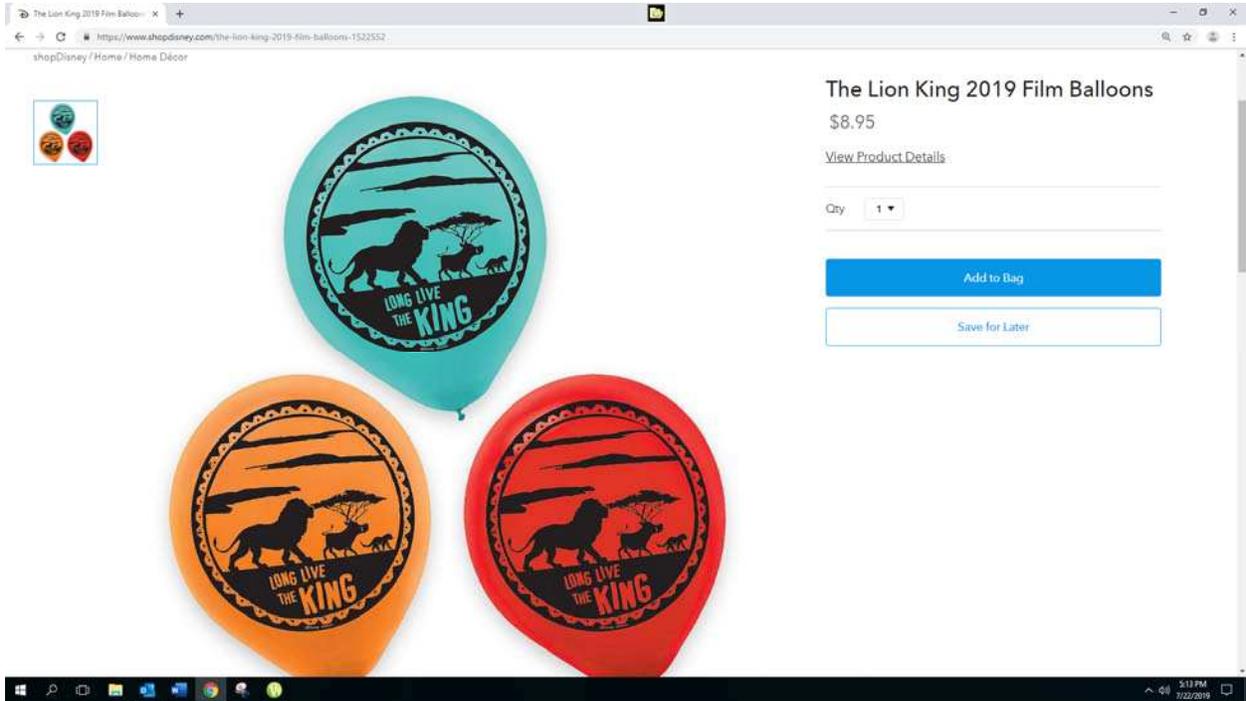
9. Opposer since at least as early as April 17, 2002 has used and licensed Opposer's HAKUNA MATATA mark in connection with consumer products, including toys, children's toys, clothing, apparel, jewelry, mugs, and other accessories, just to name a few. Representative examples of such products are shown below.





10. Opposer's consumer products bearing Opposer's HAKUNA MATATA mark are closely tied to Opposer's well-known and famous The Lion King Franchise, including using the character names and/or displaying images of several of Opposer's well-known and famous characters such as Simba, Timon, and Pumbaa.

11. In addition to the above, Opposer for decades has also used and/or licensed the use of names, marks, characters, and elements from Opposer's The Lion King Franchise across a wide variety of products, including balloons and party supplies, as shown in the representative examples below.



Opposer's Registration Rights in Its HAKUNA MATATA Mark

12. In addition to its common law rights, Opposer owns the following valid and subsisting United States trademark registration for Opposer's HAKUNA MATATA mark:

Mark	Reg. No. Date	Goods
HAKUNA MATATA	2700605 25-MAR-2003	Int. Cl. 25 T-shirts

Attached as Exhibit A are printouts of the TSDR records from the USPTO database showing the current status and title of the registration for the above mark. Opposer's HAKUNA MATATA marks identified in Paragraphs 9-10 and 12 are collectively referred to as "Opposer's HAKUNA MATATA Mark" and the goods and services identified in Paragraphs 2-12 are collectively referred to as "Opposer's Goods and Services."

13. Opposer's registration in Paragraph 12 is incontestable and constitutes conclusive evidence of Opposer's ownership of and exclusive right to use Opposer's HAKUNA MATATA Mark in commerce in connection with the products recited in the registration.

Applicant and Its HAKUNAMATATA Mark

14. Applicant Qianhai Qisheng Supply Chain Management Shenzhen Co., Ltd. is a Chinese limited company having an address of Room 201, Building A, No. 1 Qianwan 1st Road Shenzhen-Hong Kong Cooperation Zone, Qianhai, Shenzhen, China 518052.

15. Applicant is the listed owner of Application Serial No. 88191350 (the "Application"), filed on November 13, 2018 under Section 1(a), 15 U.S.C. § 1051(a), for the mark HAKUNAMATATA ("Applicant's HAKUNAMATATA Mark") for "balloons;

confetti; infant toys; inflatable thin rubber toys; novelty noisemaker toys for parties; play balloons; stress relief exercise toys; toy building blocks; toy fireworks” in Class 28 (“Applicant’s Goods”). Applicant claims a date of first use of Applicant’s HAKUNAMATATA Mark in commerce of October 1, 2018.

16. On April 2, 2019, the Application was published for opposition in the *Trademark Official Gazette* (TMOG), and on May 1, 2019, Opposer timely filed a request for extension of time to oppose the Application.

Likelihood of Confusion, 15 U.S.C. § 1052(d)

17. Opposer repeats and realleges each and every allegation set forth in the paragraphs above.

18. Opposer has priority based on its prior common law use of Opposer’s HAKUNA MATATA Mark in commerce before the filing date of the Application, Applicant’s claimed date of first use, and any date of first use that Applicant may prove. Opposer also has priority based on its pleaded valid and subsisting prior-issued registration for Opposer’s HAKUNA MATATA Mark.

19. Applicant’s HAKUNAMATATA Mark is identical in sound, appearance, connotation, and commercial impression to Opposer’s HAKUNA MATATA Mark.

20. Applicant’s Goods and Opposer’s Goods and Services offered and sold by Opposer in connection with Opposer’s HAKUNA MATATA Mark are identical or closely related goods and services.

21. Accordingly, Applicant’s HAKUNAMATATA Mark so resembles Opposer’s previously used and registered Opposer’s HAKUNA MATATA Mark as to be likely, when registered and used in connection with Applicant’s Goods, to cause confusion, or

to cause mistake, or to deceive under Section 2(d) of the Lanham Act, as amended, 15 U.S.C. § 1052(d).

WHEREFORE, Opposer believes that it will be damaged by the registration of the mark shown in Application Serial No. 88191350, and requests that the opposition be sustained, and that registration to Applicant be refused.

A filing fee has been submitted electronically. If the filing fee is found to be insufficient for any reason, please charge such deficiency to our Deposit Account No. 506154.

Respectfully submitted,

Dated: July 31, 2019

By: /Linda K. McLeod/

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Attorneys for Opposer
Disney Enterprises, Inc.

EXHIBIT A

Generated on: This page was generated by TSDR on 2019-07-30 11:32:23 EDT

Mark: HAKUNA MATATA

US Serial Number: 74558335

Application Filing Date: Aug. 08, 1994

US Registration Number: 2700605

Registration Date: Mar. 25, 2003

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Mar. 26, 2013

Publication Date: Oct. 02, 2001

Notice of Allowance Date: Dec. 25, 2001

Mark Information

Mark Literal Elements: HAKUNA MATATA

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Translation: The phrase "HAKUNA MATATA" may be translated into English as "no problem; no worries".

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *...* identify additional (new) wording in the goods/services.

For: T-shirts

International Class(es): 025 - Primary Class

U.S Class(es): 022, 039

Class Status: ACTIVE

Basis: 1(a)

First Use: Apr. 17, 2002

Use in Commerce: Apr. 17, 2002

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Amended Use: No

Filed ITU: Yes

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: DISNEY ENTERPRISES, INC.

Owner Address: 500 SOUTH BUENA VISTA STREET
BURBANK, CALIFORNIA 91521
UNITED STATES

Legal Entity Type: CORPORATION

State or Country DELAWARE
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Steven Plotkin

Attorney Primary trademarks@disney.com
Email Address:

Attorney Email Yes
Authorized:

Correspondent

Correspondent Steven Plotkin
Name/Address: THE WALT DISNEY COMPANY
500 South Buena Vista Street
IP Department - Trademark Group
BURBANK, CALIFORNIA 91521
UNITED STATES

Phone: 818-560-7646

Fax: 818-848-6424

Correspondent e- trademarks@disney.com
mail:

Correspondent e- Yes
mail Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Mar. 26, 2013	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Mar. 26, 2013	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	68502
Mar. 26, 2013	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	68502
Mar. 26, 2013	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	68502
Mar. 18, 2013	TEAS SECTION 8 & 9 RECEIVED	
Feb. 25, 2009	CASE FILE IN TICRS	
Aug. 26, 2008	POST REGISTRATION ACTION MAILED NO RESPONSE REQUIRED	
Aug. 26, 2008	ASSIGNED TO PARALEGAL	75184
Aug. 05, 2008	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	66607
Aug. 01, 2008	ASSIGNED TO PARALEGAL	66607
Jul. 24, 2008	TEAS SECTION 8 & 15 RECEIVED	
Jun. 04, 2008	NOTICE OF SUIT	
Mar. 25, 2003	REGISTERED-PRINCIPAL REGISTER	
Feb. 04, 2003	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Jan. 13, 2003	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Jan. 13, 2003	PAPER RECEIVED	
Jul. 12, 2002	NON-FINAL ACTION MAILED	
Jul. 05, 2002	ASSIGNED TO EXAMINER	62126
Jul. 03, 2002	STATEMENT OF USE PROCESSING COMPLETE	
Jun. 11, 2002	USE AMENDMENT FILED	
Jun. 13, 2002	PAPER RECEIVED	
Dec. 25, 2001	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Oct. 02, 2001	PUBLISHED FOR OPPOSITION	
Sep. 12, 2001	NOTICE OF PUBLICATION	
May 03, 2001	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jan. 09, 1998	ASSIGNED TO EXAMINER	62126
Jul. 07, 1997	ASSIGNED TO EXAMINER	62126
Jul. 03, 1997	ASSIGNED TO EXAMINER	62126
Jan. 14, 1997	ASSIGNED TO EXAMINER	62523

Jan. 12, 1997	ASSIGNED TO EXAMINER	62523
Jul. 30, 1996	ASSIGNED TO EXAMINER	72614
Jul. 08, 1996	ASSIGNED TO EXAMINER	72614
Jul. 06, 1996	ASSIGNED TO EXAMINER	72614
Jan. 03, 1996	ASSIGNED TO EXAMINER	72614
Jan. 30, 1995	LETTER OF SUSPENSION MAILED	
Jan. 19, 1995	EXAMINER'S AMENDMENT MAILED	
Jan. 11, 1995	ASSIGNED TO EXAMINER	66593

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Mar. 25, 2013

TM Staff and Location Information

TM Staff Information - None File Location

Current Location: GENERIC WEB UPDATE

Date in Location: Mar. 26, 2013

Assignment Abstract Of Title Information

Summary

Total Assignments: 2

Registrant: DISNEY ENTERPRISES, INC.

Assignment 1 of 2

Conveyance: CHANGE OF NAME

Reel/Frame: [1583/0398](#)

Pages: 4

Date Recorded: Apr. 21, 1997

Supporting Documents: No Supporting Documents Available

Assignor

Name: [WALT DISNEY COMPANY THE](#)

Execution Date: Dec. 04, 1996

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Assignee

Name: [DISNEY ENTERPRISES, INC](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Address: 500 SOUTH BUENA VISTA STREET
BURBANK, CALIFORNIA 91521

Correspondent

Correspondent Name: M. IRIS HESS

Correspondent Address: LADAS & PARRY
5670 WILSHIRE BOULEVARD
SUITE 2100
LOS ANGELES, CA 90036

Domestic Representative - Not Found

Assignment 2 of 2

Conveyance: CHANGE OF NAME

Reel/Frame: [1607/0628](#)

Pages: 13

Date Recorded: Apr. 21, 1997

Supporting Documents: No Supporting Documents Available

Documents:**Assignor**

Name: [WALT DISNEY COMPANY, THE](#)
Legal Entity Type: CORPORATION
Execution Date: Dec. 04, 1996
State or Country Where Organized: DELAWARE

Assignee

Name: [DISNEY ENTERPRISES, INC.](#)
Legal Entity Type: CORPORATION
Address: 500 SOUTH BUENA VISTA STREET
 BURBANK, CALIFORNIA 91521
State or Country Where Organized: DELAWARE

Correspondent

Correspondent Name: LADAS & PARRY
Correspondent Address: 5670 WILSHIRE BOULEVARD
 SUITE 2100
 LOS ANGELES, CA 90036

Domestic Representative - Not Found

Proceedings

Summary

Number of Proceedings: 1

Type of Proceeding: Opposition

Proceeding Number: [91244784](#)
Filing Date: Nov 13, 2018
Status: Terminated
Status Date: Feb 23, 2019
Interlocutory Attorney: YONG OH (RICHARD) KIM

Defendant

Name: Zhang Laixiang
Correspondent Address: ZHANG LAIXIANG
 SHANGHANGXIAN BUYUNXIANG JINPINGCUN 72
 LONGYAN , 364223
 CHINA
Correspondent e-mail: leosusie@foxmail.com , trademark@hakunamatatashops.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
HAKUNA MATATA	Abandoned - After Inter-Partes Decision	87194495	

Plaintiff(s)

Name: Disney Enterprises, Inc.
Correspondent Address: LINDA K MCLEOD
 KELLY IP LLP
 1300 19TH ST NW, SUITE 300
 WASHINGTON DC , 20036
 UNITED STATES
Correspondent e-mail: linda.mcleod@kelly-ip.com , lit-docketing@kelly-ip.com , clint.taylor@kelly-ip.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
HAKUNA MATATA	REGISTERED AND RENEWED	74558335	2700605

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Nov 13, 2018	

2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Nov 15, 2018	Dec 25, 2018
3	INSTITUTED	Nov 15, 2018	
4	NOTICE OF DEFAULT	Jan 04, 2019	
5	BD DECISION: OPP SUSTAINED	Feb 23, 2019	
6	TERMINATED	Feb 23, 2019	